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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,296	04/22/2004	Daisuke Shibai	0425-0866PUS2	7192

2292 7590 05/12/2005

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EXAMINER

ZALUKAEVA, TATYANA

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 05/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/829,296

Applicant(s)

SHIBAI ET AL.

Examiner

Tatyana Zalukaeva

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/994,651.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>04/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 10 and 11 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of copending Application No. 10/872,379. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of copending

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Application No. 10/872,379. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claim methods of dispersing substantially the same compositions using the same products .

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

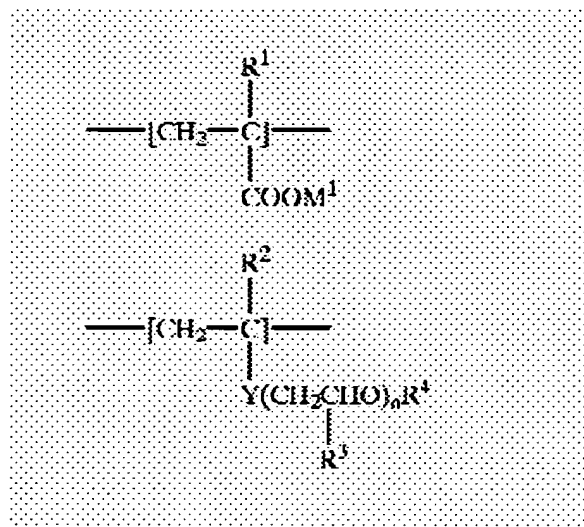
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-11 are rejected and new claims 13-30 are under 35 U.S.C. 102(e) as being anticipated by Isomura et al (U.S. 6,437,027).

Isomura discloses method of dispersing hydraulic composition by using powdery dispersant (abstract, col.8, lines 36-65) which is obtained from a copolymer that is a(meth)acrylate polymer having polyalkylene glycol chain (col. 2, lines 60-65). Of the aforementioned copolymers , preferable ones are acrylate or methacrylate polymer

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compounds comprising at least two different structural units represented by the following formulas (1) and (2) (col. 3, lines 21-25):



wherein the meaning of all substitute groups and the amounts of these groups are clearly the same as instantly claimed (see col. 3, lines 40-55).

More preferable (meth)acrylate copolymers (A) are (meth)acrylate copolymers having a number average molecular weight of 2,000-50,000, which comprise structural unit (5) represented by the following formula (5) in an amount of 40-70 mol %, structural unit (6) represented by the following formula (6) in an amount of 5-30 mol %, structural unit (7) represented by the following formula (7) in an amount of 1-20 mol %, structural unit (8) represented by the following formula (8) in an amount of 1-30 mol %, and structural unit (9) represented by the following formula (9) in an amount of 1-30 mol %: (col. 4, lines 45-65 – col. 5, lines 1-50). This specifically read on the instant claims 1-4, 13, 14. With regard to number of oxyalkylene groups, Isomura teaches the ranges as instantly claimed in col. 3, lines 14-20. With regard to claim 9, Isomura teaches that obtained powder was crushed by means of a crusher (type MCG 180, product of Matsubara), to

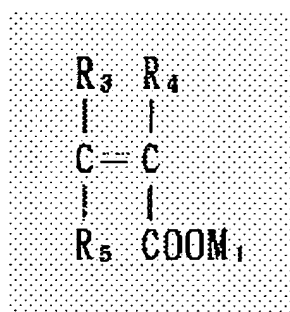
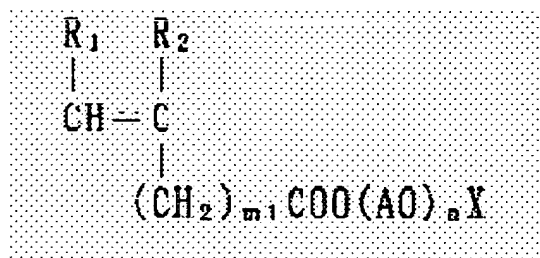
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thereby prepare powdery cement dispersants (1) and (2) having a particle size of 50-500 μm as shown in Table 7.

Therefore, all the limitations of the instant claims are met by the disclosure of Isomura.

6. Claims 1-11 are rejected under 35 U.S.C. 102(b) as being clearly anticipated and by JP 09328345.

JP'345 discloses an admixture for concrete improving by of a copolymer, a high quality water reducing agent, a water-soluble polymer and a defoaming agent, with a specific molar ratio of monomers forming the copolymer and the average molecular weight of the copolymer. The copolymer is obtained by copolymerizing monomers of formula I and II.



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The molar ratio of the monomer of formula I to that of formula II is (1/90) to (50/50). A weight average molecular weight (measured by a gel- permeation chromatography method and reduced to a sodium polystyrenesulfonate) is 3,000-200,000. An aromatic water reducing agent is used as the high quality water reducing agent. A polyalkylene glycol derivative is used as the water-soluble polymer. A product having an excellent surface appearance is obtained by using the admixture for the concrete.

7. Claims 1-8 stand rejected under 35 U.S.C. 102(b) as being anticipated by JP 2000086315.

JP'315 discloses an additive combined having a high flowability-imparting property to hydraulic compositions and an improved clay viscosity-imparting property, satisfying a standard strength, and useful for the hydraulic compositions.

This additive for hydraulic compositions comprises a copolymer having two major comonomers (A) and (B) in a weight ratio of 5/95 to 95/5. A vinylic copolymer containing 2-3C polyoxyalkylene groups (average addition mole number: 2-300) in the molecule and having a weight-average mol.wt. of 5,000-500,000. A polymer having a mol.wt. of 1,000-20,000 and prepared by copolymerizing one or more monomers of the formula (A) and formula (B), wherein R1 is hydrogen atom or methyl group; R2, R3 are each hydrogen atom, methyl group or $M_2O(CO)(CH_2)_{m_1}$; M1, M2 are each hydrogen atom, an alkali metal, an alkaline earth metal, ammonium, or a mono-, di- or tri-alkylammonium which may be substituted by a hydroxyl group; (m_1) is an integer of 0-2. (see abstract).

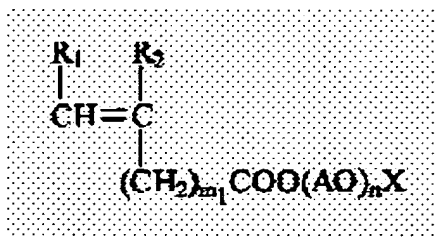
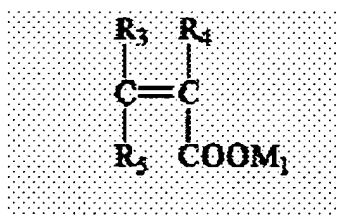
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8. Claims 1-11 and 13-20 are rejected under 35 U.S.C. 102(a) as being anticipated by JP 20026146.

JP'146 discloses powdered cement dispersant containing a polycarboxylic acid based high molecular compound, powder preferably has 5-2,000 μm average particle diameter. The polycarboxylic acid type high molecular compd. is preferably a (meth)acrylic acid or maleic acid copolymer having a number average mol.wt. of about 2,000-50,000.(abstract). The possible structural units of a polymer are shown in col.3, lines 23-40. , col. 5 and 6 .

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. JP 2000103660 discloses a copolymer prepared by polymerizing monomer mixture mainly comprising two monomers as main components.

The monomer mixture contains a monomer represented by formula I, and one or more kinds of monomers represented by formula II as main components.



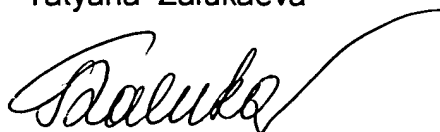
JP 2000044309 discloses an additive capable of imparting fluidity and fluidity-keeping properties to fine aggregates produced at any place by including a vinyl-based polymer having an oxyalkylene group having specific numbers of carbons in a molecule, and a specified average molecular weight. This additive comprises a vinyl-based polymer having a 2-3C oxyalkylene group in a molecule, and 500-500,000 numberaverage molecular weight (e.g. methanol-EO-monoester of methacrylic acid/Na acrylate), and a cationic compound having a tertiary N atom.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tatyana Zalukaeva whose telephone number is (571) 272-1115. The examiner can normally be reached on 9:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tatyana Zalukaeva

A handwritten signature in black ink, appearing to read 'Zalukaeva', with a long, sweeping horizontal stroke extending to the right.

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Primary Examiner
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May 9, 2005